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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,080	04/26/2001	Philippe J. Goix	A-69516/AJT	9621

7590 11/18/2004  
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EXAMINER

GABEL, GAILENE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/844,080

Applicant(s)

GOIX ET AL.

Examiner

Gailene R. Gabel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1,3-8,10,11 and 34-37.Claim(s) withdrawn from consideration: 12-33.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
11/10/04

## **ADVISORY ACTION**

### ***Amendment Entry***

1. Applicant's amendment and response 10/4/04 is acknowledged and has been entered. Claims 1, 5, 10, 11, and 35 have been amended. Claim 9 has been cancelled. Claims 12-33 and 38 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being claims drawn to a non-elected invention. Accordingly, claims 1, 3-8, 10-38 are pending. Claims 1, 3-8, 10, 11, and 34-37 are under examination.

### **Rejections Withdrawn**

#### ***Claim Rejections - 35 USC § 112***

2. In light of Applicant's amendment, the rejection of claims 35-37 under 35 U.S.C. 112, second paragraph, is hereby, withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3, 5, 8, and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goix (WO 98/57152) in view of D'Autry (Derwent Accn. No. 1973-26106U or US Patent 3,827,304) for reasons of record. This rejection is being maintained in light of convention in the art and motivation to incorporate a pump upon a capillary tube so as to alternatively draw (negative pressure = D'Autry) rather than inject (positive pressure = Goix) a sample through the capillary tube. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to incorporate a capillary and pump such as in the analytical apparatus taught by D'Autry into the apparatus as taught by Goix because D'Autry specifically taught that such configuration provides many different advantages including accuracy from elimination of carry-over contamination, reduction in the volume of sample required, reduction in time required for analysis, and adaptability with automation. Accordingly, one of ordinary skill in the art at the time of the instant invention would have been motivated to incorporate the capillary and pump as taught by D'Autry into the apparatus of Goix.

The following references by Welch et al. (US Patent 5,302,264, Figure 1), Gorog (US Patent 5,599,718, Figure 1), Fulwyler et al. (US Patent 6,610,499), and Wilson et al. (US Patent 5,849,598) teach the concept of positive and negative pressure in flow

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devices and exemplify configurations supporting the conventionality of embodiment recited in the claimed invention. Claim 1 recites, "a pump connected to the first end of the capillary tube with the second end of the capillary tube being suspended for immersion ... serving to draw sample fluid into the second end ... to cause particles in said fluid to flow along the capillary tube."

4. Claims 6, 10, and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of D'Autry (Derwent Accn. No. 1973-26106U or US Patent 3,827,304) as applied to claims 1-3, 5, 8, and 34 above, and further in view of Hirako (US 5,135,302) for reasons of record.

5. Claims 35-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of D'Autry (Derwent Accn. No. 1973-26106U or US Patent 3,827,304) as applied to claims 1-3, 5, 8, and 34 above, and further in view of Bernstein et al. (US 5,478,750) for reasons of record.

6. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of D'Autry (Derwent Accn. No. 1973-26106U or US Patent 3,827,304) as applied to claims 1-3, 5, 8, and 34 above, and further in view of Mochida et al. (US 5,147,607) for reasons of record.

7. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of D'Autry (Derwent Accn. No. 1973-26106U or US Patent 3,827,304) as applied to claims 1-3, 5, 8, and 34 above, and further in view of von Behrens et al. (US 5,378,633) for reasons of record.

***Response to Arguments***

8. Applicant's arguments filed 10/04/04 have been fully considered but they are not persuasive.

A) Applicant argues that D'Autry does not teach or suggest a capillary, but rather a pipet. Applicant specifically contends that the sample is not drawn past an analyzing volume where it is analyzed, but rather is drawn past the volume and then pumped back through the volume for analysis.

In response, Goix is relied upon for the disclosure of a flow apparatus which comprises a capillary channel configured to admit particles one at a time, i.e. singulate, as a sample volume passes through analysis area, a pump for introducing a sample containing the particles through the channel and flowing the particles along the capillary channel into its other end. The apparatus further includes a light source (laser) which generates a laser beam for illumination and focus through one or more lenses onto a test volume of the sample being analyzed. The apparatus also includes a detector, i.e. photomultiplier tube, for detecting particles that flow along the capillary tube, the detector having a collecting lens for intercepting fluorescent light emitted by particles, and a slit in front of the photomultiplier tube to block unwanted light. D'Autry is relied upon only for the secondary teaching of an apparatus having a capillary tube with an end upon which a sample is introduced by immersion of the pipette into the sample and the other end connected to a pump which serves to draw sample into the second end of the channel.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to incorporate the capillary and pump as taught by D'Autry into the apparatus of Goix because such configuration is conventional and well known in the art for providing accuracy from elimination of carry-over contamination, reduction in the volume of sample required, reduction in time required for analysis, and adaptability with automation.

9. For reasons aforementioned, no claims are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (571) 272-0820. The examiner can normally be reached on Monday, Tuesday, and Thursday, 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gailene R. Gabel  
Patent Examiner  
Art Unit 1641  
November 10, 2004

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GROUP 1800/641  
11/11/04